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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,915	04/21/2004	Daniele Fatutto	SAIC 21.081	5639
21001	7590	08/31/2006	EXAMINER	
NORRIS, MC LAUGHLIN & MARCUS, PA 875 THIRD AVENUE, 18TH FLOOR NEW YORK, NY 10022			BECKER, DREW E	
		ART UNIT	PAPER NUMBER	
			1761	

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/828,915	FATUTTO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Drew E. Becker	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 June 2006.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 4-7,10-12 and 14-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 4-7,10-12 and 14-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4-7, 10-12, and 14-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant did not point out where support is found for the new claim limitations. Specifically, the application does not appear to support at least: the limitation "the wine having reduced volatile acidity and containing substantially all the other components of the wine" in claim 19, and "while retaining substantially all other components" in claim 21.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-12 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

5. Claims 10-11 recite "it". It is not clear what "it" is.
6. Claim 19 recites "a two-step process". However, claim 21 includes more than two steps, for instance the collection step.
7. Claim 19 recites "a second process station... for separation of the compounds... from the remainder of the wine". It is not clear how "the wine", which had presumably been separated earlier into two components, can now be separated again.
8. Claim 19 recites "the wine having reduced volatile acidity and containing substantially all the other components of the wine". It is not clear how this is possible since the wine has undergone two distinct filtration-separation steps.
9. Claim 21 recites "while retaining substantially all other components". It is not clear how this is possible since the wine has undergone two distinct filtration-separation steps.
10. Claim 21 recites the first station having both a "first membrane means" and a "second membrane means", yet also recites replacing the first membrane with the second membrane. It is not clear whether one, or both, are present.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 5, 7, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonneau [Pat. No. 4,499,117].

Bonneau teaches batch process for treating wine by using a first stage comprising ultrafiltration through a membrane to produce a first permeate and a first concentrate (column 4, lines 5-25), a second stage comprising reverse osmosis via a membrane to produce a second concentrate and a second permeate (column 4, lines 26-55), recovering the second permeate (column 4, line 45), reduction of volatile acidity (column 5, line 11), and the use of pressure (column 3, lines 20 & 45).

13. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith [Pat. No. 5,480,665].

Smith teaches a device for reducing acidity in wine comprising a process station (Figure 2), a membrane means which was inherently removable for repair and replacement (Figure 2, #300), a first reservoir (Figure 2, #20), a second reservoir (Figure 2, #310), and collection means (Figure 1, #190). Phrases such as "for the discontinuous selective removal of..." and "where, in operation, the first reservoir..." are merely preferred methods of using the claimed apparatus.

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau in view of Smith [Pat. No. 5,480,665].

Bonneau teaches the above mentioned concepts. Bonneau does not recite mixing the second permeate and first concentrate with the initial solution, or a continuous process. Smith teaches a continuous process for treating wine by a first stage comprising filtration through a membrane to produce a first permeate and a first concentrate (Figure 1, #80), a second stage comprising separation to produce a second concentrate and a second permeate (Figure 1, #160), and mixing the second permeate and first concentrate with the initial solution (Figure 1, #210). It would have been obvious to one of ordinary skill in the art to incorporate the continuous recycling of Smith into the invention of Bonneau since both are directed to methods of treating wine, since Bonneau already produced a first concentrate and second permeate (column 4, lines 5-55) as well as mixing of various components (column 4, line 61), and since Smith teaches that mixing the first concentrate and second permeate with the initial solution permitted further separation as well as replacing the desirable components back into the bulk wine (column 2, line 25).

16. Claims 4, 14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau as applied above, in view of Viallette nee Geolier [Pat. No. 4,461,778].

Bonneau teaches the above mentioned concepts and components. Bonneau does not recite an intermediate stage which adds substance to the first permeate, the substances being sodium, potassium, or calcium compounds, means for performing the

intermediate stage, and the substances being hydroxides, carbonates, tartrates and acetates of sodium, potassium and calcium. Viallette nee Geolier teaches a process for deacidifying wine by adding calcium carbonate or calcium tartrate to the wine (column 2, line 19). It would have been obvious to one of ordinary skill in the art to incorporate the deacidifying step of Viallette nee Geolier into the invention of Bonneau since both are directed to methods of treating wine, since Bonneau already included removal of volatile acids and provided a filtration step (column 4, lines 26-55) capable of removing the crystals produced by Viallette nee Geolier (column 4, line 21), and since the deacidification of Viallette nee Geolier would have further helped remove undesirable malic acid (column 1, lines 4-25).

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Viallette nee Geolier, as applied above, and further in view of Heess et al [Pat. No. 4,322,446].

Bonneau and Viallette nee Geolier teach the above mentioned concepts. Bonneau and Viallette nee Geolier do not recite an upright container with a grille, a tank, and a siphon. Heess et al teaches a device for treating wine by passing it through a station consisting of a tank with a bottom drain or siphon, the tank containing upright containers comprising grilles that hold calcium tartrate (Figure 1). It would have been obvious to one of ordinary skill in the art to incorporate the structure of Heess et al into the invention of Bonneau, in view of Viallette nee Geolier, since all are directed to wine treating methods and devices, since Bonneau already included filtration, since Viallette nee Geolier already included additives such as calcium tartrate (column 2, line 20), and

since the structure of Heess et al provided a means for continuous production with the need for mixing and stirring.

18. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Viallette nee Geolier, as applied above, and further in view of CN 1133882A.

Bonneau and Viallette nee Geolier teach the above mentioned concepts. Bonneau and Viallette nee Geolier do not recite filter means before initial processing. CN 1133882A teaches a device for treating wine including a filter means (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the filtering means of CN 1133882A into the invention of Bonneau, in view of Viallette nee Geolier, since all are directed to devices for treating wine, since Bonneau already included fine filtering such as ultrafiltration and reverse osmosis, and since the preliminary filtering of CN 1133882A would have prevented larger particles from clogging the ultrafiltration membrane of Bonneau.

19. Claim 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonneau, in view of Viallette nee Geolier and Heess et al, as applied above, and further in view of Smith.

Bonneau, Heess et al, and Viallette nee Geolier teach the above mentioned concepts. Bonneau, Heess et al, and Viallette nee Geolier do not recite pumps. Smith teaches a device for treating wine comprising a pump (Figure 1, #60). It would have been obvious to one of ordinary skill in the art to incorporate the pump of Smith into the invention of Bonneau, in view of Viallette nee Geolier and Heess et al, since all are directed to

devices for treating wine, since Bonneau would have required some means for conveying the fluids, and since the pump of Smith provided a convenient and efficient means for supplying wine and its components.

### ***Response to Arguments***

20. Applicant's arguments filed 6/30/06 have been fully considered but they are not persuasive.

Applicant argues that "it" is a clear term for wine. If this is the case, then applicant should have no problem simply replacing the term "it" with wine or whatever component is meant.

Applicant argues that Bonneau does not teach a two step process. However, the claims (except claim 19) do not mention a two step process. In response to applicant's arguments, the recitation "a two-step process" in claim 19 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant argues that Bonneau does not recite the same affects as applicant. However, the method Bonneau is identical to that claimed by applicant, therefore they would have the same affects.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., high pressure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 5 merely recites "under pressure". Practically any pressure level would meet this limitation whether it is ambient, above ambient, or below ambient.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues that Bonneau cannot use or incorporate other methods. However, Bonneau specifically recites "the present invention is not limited to the embodiments described above... it embraces all of the variants such as those in particular which relate to the nature of the ultrafiltration or reverse osmosis" (column 6, line 10). Smith is directed to reverse osmosis of wine (abstract). The test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that Vialatte nee Geolier removes malic acid, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### **Conclusion**

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DREW BECKER  
PRIMARY EXAMINER  
8-29-06